Supreme Court, U.S.
FILED

(1)

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No. OFFICE OF THE CLERK

IN THE

Supreme Court of the United States
October Term 19__

IN RE DONALD R. MILLIGAN

v

United States Court of Appeals for the Federal Circuit

United States Patent and Trademark Office
Before the Board of Patent Appeals
and Interferences

On Petition for Writ of Certiorari
To The United States Patent and Trademark Office

PETITION FOR WRIT OF CERTIORARI

DONALD R. MILLIGAN
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74014-2525
918-357-2600

92 pp

STATEMENT OF THE QUESTION

Will The Supreme Court of the United States allow the conditions for patentability evidence projected by The United States Office of Patent and Trademarks that my invention´s new composition is **ANTICIPATED** by "inherency" or **OBVIOUS** in the market place stand as fact?

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STATEMENT OF THE QUESTION

A. **THERE IS ONLY ONE (1) QUESTION.**

1. Will the **PATENTABILITY EVIDENCE** presented by the Office of Patent and Trademarks that a **LISTING** of a named chemical, produced for over fifty (50) years, is the **PROOF** needed to **REJECT** my **NEW DRUG** found to relieve the pain and heal the damaged tissue of:

ARTHRITIS, RESPIRATORY DISEASE, and CANCER?

2. Will Lange´s Handbook of Chemistry page 7-472, No. L2, or The Merck Index, Tenth Edition, No. 5173 [A16, 24, 25, 36, 39, 43, 44, 55] presented as prior art by the Office of Patent and Trademarks to reject my **NEW DRUG´S** (1) combination of substances in proportions, (2) dosages of and methods of treating the diseases listed in my applications be allowed to stand as **"JUSTIFIED EVIDENCE?"**

3. The question is, **"WHAT IS A CHEMICAL?"**

4. The question is, **"WHAT IS A NEW DRUG?"**

B. This is **ARTHRITIS and CANCER** we are talking about!

STATEMENT OF RELATED CASES

A. This original application for patent was divided under authority 35 U.S.C. § 120 and § 121 by the Examiner.

MILLIGAN 07/396,361 dated AUGUST 21, 1989 (ARTHRITIS). [A58, 60].

MILLIGAN 07/796,663 dated November 25, 1991, (RESPIRATORY). [A62].

MILLIGAN 07/796,664 dated November 25, 1991, (NEURALGIA).[A65].

MILLIGAN 08/744,286 dated November 6, 1996, (CANCER).[A68].

1. This appeal represents an **eight (8) year** endeavor to keep alive my invention. The original claims and application was divided and later decried of double patenting. [A1, 26, 38].

2. These applications were adjudged by The APPEALS COURT for the FEDERAL CIRCUIT as AFFIRMED:

96-1419, MILLIGAN 07/396,361, AFFIRMED November 13, 1996. [A15].

97-1094, MILLIGAN, 07/796,663 and 97-1093, MILLIGAN, 07/796,664 AFFIRMED April 10, 1997. [A6, 9].

3. Now the fourth application has been recently, November 6, 1996, licensed

MILLIGAN 08/744,286 Dated August 21, 1989. TREATING CANCER. [A68].

B. Cancer treatment has been confirmed by ONCOLOGY TECHNOLOGIES INC. [A71] Irving, California as controlling human cancer tumor damage. This **APPEAL** is to present that all these four applications have a **COMMON** and only one piece of **PATENTABILITY EVIDENCE,** a listed chemical, being called a basis for the **COMMON** rejection of a patentable invention.

C. The Patent will allow the time to develop this property for the benefit of humanity.

STATEMENT OF JURISDICTION

A. These applications have been individually **APPEALED** and consistently rejected using the same common conditions for patentability and it is reasonable to present these rejections in chronological order disclosing the astoundingly constant pattern to obfuscate the meaning of 35 U.S.C. § 102: [A25, 44].

> In re King, 801 F.2d 1324. In re King, p. 1324 4. "After Patent and Trademark Office establishes prima facia case of anticipation based on inherency, burden shifts to

> applicant to prove that subject matter shown to be in prior art does not possess characteristics relied upon. 35 U.S.C.A. § 102."

In all of **KING** the discussion or revelation was about the details of the **PRIOR ART.**

> In re KING OPINION, p. 1326, first sentence: "It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question subject to review under the clearly erroneous standard. * * *.

B. The chronological order of rejections containing **LANGE and MERCK** as the condition for patentability can only lead to the **"PETITION FOR THE WRIT OF CERTIORARI."**

CHRONOLOGICAL ORDER OF EVENTS

DATE	EVENT	IN RE
Aug 21, 1989	Application	'361
May 13, 1991	Appealed	'361
Nov 25, 1991	Applications	'663 '664
Mar 8, 1993	Appealed	'664
Apr 20	Appealed	'663
May 14	Decision Reversed	'361
Nov 8	Appealed	'361
Jun 20, 1995	Appeal remanded	'663
Feb 22, 1996	Decision on Appeal	'361
Feb 22	Decision on Appeal	'664
Mar 18	Request for Reconsider	'361

Mar 18	Request for Reconsider	´664
Mar 29	Reconsideration Denied	´361
May 20	Notice of Appeal CAFC	´361
May 23	NOTICE OF ABANDONMENT	´361
May 23	NOTICE OF ABANDONMENT	´664
Jun 17	ABANDONMENT WITHDRAWN	´361
Jun 17	Decision on Appeal	´663
Jul 2	Request for Reconsider	´663
Jul 10	Appeal Federal Circuit	´361
Aug 30	Reconsideration Denied	´663
Sep 18	Appeal Federal Circuit	´663
Sep 18	Appeal Federal Circuit	´664
Sep 20	NOTICE OF ABANDONMENT	´663
Nov 7	ABANDONMENT WITHDRAWN	´663
Nov 13	CAFC Appeal AFFIRMED	´361
Nov 19, 1996	ABANDONMENT VACATED	´664
Dec 17	Reconsideration Denied	´664
Apr 10, 1997	CAFC Appeal AFFIRMED	´663
APR 10	CAFC Appeal AFFIRMED	´664
May 13	NOTICE OF ABANDONMENT	´361
May 29, 1997	Petition against ABANDONMENT ´361.	

November 6, 1996 Cancer Application submitted.

Feb 23, 1997 FOREIGN FILING LICENSE GRANTED 02/23/97, 08/744,286, *SMALL ENTITY*, NEUROLACTIC ACTIVOR, CONTINUING DATA AS CLAIMED BY APPLICANT-THIS APPLN

DATE	EVENT	IN RE
IS A DIV OF 07/396,361 08/21/89.		
Jun 5	Rejection all claims	´286
Jul 21	Applicant´s Rebuttal	´286

END OF CHRONOLOGY

C. Jurisdiction leads from eight (8) years endeavor using 35 U.S.C. § Chapter 10, § 100 thru § 142 comes to conclusion at the Supreme Court of the United States. 35 U.S.C. § 101 is quoted:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof; may obtain a patent therefor, subject to the conditions and requirements of this title."

D. The Patent is requested under the authority of:

The

CONSTITUTION

of the United States

Article I, Section 8, paragraph 8:

> "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;"

STATEMENT OF THE CASE

A. THE STANDARD OF REVIEW.

1. This appeal can only be judged under The Substantial Evidence of Fact.

B. **THE DIVIDED APPLICATION.**

1. These applications have been separated into **DIVISIONAL APPLICATIONS.** The Patent Process of the **LAW 37 C.F.R. § 1.142 (a)** used by the Examiner to:

DIVISIONALLY SEPARATE

MILLIGAN 07/396,361

FOLLOWS.

11/11/89 EXAMINER´S OFFICE ACTION, **MILLIGAN 07/396,361** page 2, paragraph 2 is quoted:

> "The several inventions are independent and distinct, each from the others because a reference anticipating the invention of one group above would not render the invention of the other groups obvious under 35 USC § 103. Further, the claims reading on a multitude of symptoms which would require many fields of search that would be an undue burden to the Examiner." [A58].

02/06/90 EXAMINER´S OFFICE ACTION, **MILLIGAN 07/396,361** page 2, paragraph 3 is quoted:

> "There is no need to file additional applications at this time. Since additional applications can be filed anytime while this application is pending and can be entitled to the August 21, 1989 filing date."

01/23/92 EXAMINER´S ANSWER, **MILLIGAN 07/396,361** Paper No. 20, page 1, (1)

Status of claims is quoted:

> "A correct statement of the status of claims is as follows: The restriction requirement of November 29, 1989 require the applicant to elect one invention. The applicant elected Group I (treating joint pains)."

2. The application was divided [A24, 47]. Arthritis [A60], Neuralgia [A65], and Respiratory [A62] were submitted and rejected. Now Cancer has been licensed.

C. **THE DOUBLE PATENTING.**

1. **MILLIGAN 07/796,663 RESPIRATORY** [A19, 47], **MILLIGAN 07/796,664 NEURALGIA** [A37, 38] were impugned as **"DOUBLE PATENTING.** Both applications were clearly stated as parts of a divided application 35 U.S.C. § 120 and § 121. The division was never recognized no matter how many times it was mentioned. [A18, 24].

2. Now **MILLIGAN 08/744,286** is also being designated filing date of 11/06/96 even when it has been licensed 08/21/89.

D. **THE CONDITIONS FOR PATENTABILITY ISSUE.**

1. There are two pieces of literature used as **CONDITIONS FOR PATENTABILITY EVIDENCE.**

NO OTHER EVIDENCE CAN BE FOUND.

2. 35 U.S.C. § 102 is being used as the

justification to reject all these applications that **LANGE ANTICIPATES** [A1, 2, 16, 25, 44] these inventions.

3. **The Lange's Handbook of Chemistry (see page 7-472 No. L2)**. [A 16, 24, 25, 39, 43, 44, 45, 55]

LANGE IS QUOTED

Page 7-472

(2) Name	(3) Formula	(4) Formula weight	(5) Beil Ref.
Lactic Acid	NA	NA	NA

(6) Density	(7) Refractive Index	(8) Melting Point °C	(9) Boiling Point °C
NA	NA	NA	NA

(10) Flash Point °C.	(11) Solubility in 100 Parts		
	Water	Alcohol	Ether
NA	v	s	sq

4. 35 U.S.C. § 103(a) is being used as the justification to reject all these applications that the subject matter would have been obvious at the time the invention was made to a person having ordinary skill in the art.

5. **The Merck Index,** AN ENCYCLOPEDIA OF CHEMICALS, DRUGS, AND BIOLOGICALS, TENTH EDITION, No. 5173.

MERCK IS QUOTED

5173 Lactic Acid-* * *. [A24, 26, 36, 39] **USE** * * * in manuf lactates which are

used in food products, in medicine, and in solvents * * *.

THERAP CAT: Acidulant:

THERAP CAT VET: Has been used as a caustic and in dilute solutions to irrigate tissues." (end of Quote).

6. The EXAMINER, the BOARD OF PATENT APPEALS, and the JUDGES at the COURT OF APPEALS for the FEDERAL CIRCUIT agree that this invention is [A16, 17, 39, 54] "incredible", but not once has anyone of the Medical World stepped forward to present any medical use substitution for this invention.

7. Patentability evidence has been presented in all my papers without anyone addressing in detail the admissible evidence which bases the prima facia case that my invention is anticipated [A47, 43, 44, 48] by **"LANGE"** or obvious [A19, 20, 24, 25] by **"MERCK"**.

8. In re King, 801 F.2d 1324, 1326."

> In re King, p. 1324 4. "After Patent and Trademark Office establishes prima facia case of anticipation based on inherency, burden shifts to applicant to prove that suject matter shown to be in prior art does not possess characteristics relied upon. 35 U.S.C.A. § 102."

9. In all of **KING** the discussion or

revelation was about the details of the **PRIOR ART.**

> In re KING, OPINION, p. 1326, first sentence: "It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question subject to review under the clearly erroneous standard. * * *.
>
> KING continues: [2] Under the principles of inherency, if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim of an application, the claim is anticipated. This is not to say that the discovery of a new use for an old structure based on unknown properties of the structure might not be patentable to the discoverer as a process. In re Hack, 245 F.2d 246, 248.

10. The Judges, and Examiner present an item in a Reference Chemistry Handbook that lactic acid is soluble [A56] and then they refer to the reference of that item as containing a prima facia case of the functional composition of proportions, a dosage, a method of treatment, and the diseases as my applications present.

11. LANGE'S HANDBOOK OF CHEMISTRY listing lactic acid as soluble in 100 parts of water or that MERCK'S ENCYCLOPEDIA OF CHEMICALS, DRUGS, AND

BIOLOGICALS, presents an anticipation or makes my invention obvious does not represent a **KNOWN INVENTION OF MEDICINE** used or patented or described in this country.

12. Presenting this evidence of **ANTICIPATED INVENTION** or **OBVIOUS INVENTION**, to represent that a formula of stated proportions, treatment applications, dosage boundries, and the national disease afflictions of these diseases is unimportant and without utility [A2, 3, 4, 7, 17, 37, 53] is the epitome of irrelevant.

13. **NEW DRUG DEFINITION FOLLOWS:**

The United States **LAW** Food and Drugs **21 CODE OF FEDERAL REGULATIONS** PART 310.3(h) Definitions and interpretations is quoted:

LANGE'S LISTING OR MERCK'S LISTING	**THE FOOD & DRUG DEFINITION** of a **NEW DRUG**
irrelevant	**(h) The newness of a drug * * *.**
irrelevant	**(1) * * of any new substance * *.**
irrelevant	**(2) * * combination of two or more ****
irrelevant	**(3) * * porportion**

of a substance * *

irrelevant (4) * * diagnosing, curing, mitigating

irrelevant (5) * * dosage or method

14. **LANGE'S** chemical, lactic acid, is soluble, produced for over fifty (50) years, and informative of a chemical item. It is irrelevant in describing a **NEW DRUG.**

15. **MERCK'S** chemical information is that lactic acid is used to make a **SALT** that is used in medicine, is **ACIDIC,** and the **VETERINARIANS** use it to irrigate tissues with a **CAUSTIC.** It too is an irrelevant obviousness describing this **NEW DRUG.**

16. In re Vaeck, 947 F.2d 488, 496.

> In re VAECK, 2. "* * *, court considers whether prior art would have suggested to those of ordinary skill in art that they should make claimed composition or device, or carry out claimed process, and whether prior art would also have revealed that in so making or carrying out, those of ordinary skill would have reasonable expectation of success; both suggestion and reasonable expectation of success must be found in prior art, not in applicant's disclosure. 35 U.S.C.A. § 103."

17. Lactic Acid listed as referenced in **LANGE** or **MERCK** is infinitely soluble, a dangerous caustic, used to make a

SALT-LACTATE, and produced over 50 years ago. **HOW** is this a prima facia case of **ANTICIPATED**--TO PREVENT BY ACTION IN ADVANCE? (SEE WEBSTER'S DICTIONARY-anticipated)

18. 34 USPQ 2d, In re Brana, No. 93-1393, U.S. Court of Appeals Federal Circuit page 1439:

> "At issue in this case is an important question of the legal constraints on patent office examination practice and policy. The question is, with regard to pharmaceutical inventions, what must the applicant prove regarding the practical utility or usefulness of the invention for which patent protection is sought. This is not a new issue, it is one which we would have thought had been settled by case law years ago. * * * .
>
> The requirement that an invention have utility is found in 35 U.S.C. § 101: "Whoever invents . . . any new and useful. . .composition of matter. . .may obtain a patent therefor, . . ."(emphasis added). It is also implicit in § 112 para 1, which reads:
>
> > The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> Obviously, if a claimed invention does not have utility, the specification cannot enable one to use it." (end of quote).

19. The Examiner, the Board of Appeals Judges, nor the Court of Appeals for the Federal Circuit Judges do not present Patentability Evidence in **LANGE or MERCK** of any degree sufficiency to **REJECT** my **NEW DRUG.**

THIS IS IMPORTANT--------THIS IS IMPORTANT

20. Even though the Office of Patent and Trademark Examiner and Judges disbelieved my **NEW DRUG'S** utility and that my claims were **INCREDIBLE** [A16, 17, 39, 54], my attempt, in the last minute, to submit the personal data of my journal in **AFFIDAVIT** [A4, 5, 16, 17, 20, 32] form **WAS ALSO REJECTED AS IMMATERIAL.**

21. 37 C.F.R. § 1.197(b) was made law by 54 FR 29552, July 13, 1989 that **all grounds will be presented with "REQUEST FOR RECONSIDERATION.**

22. In re Hogan, 76-641 (Fed. Cir. 1977), 559 F2d 595, 602 page 595:

> "1. Patents -97 Party seeking right under patent statutes may avail themselves of all their provisions and courts may not deny him benefit of a single one; these are questions not of natural but of purely statutory rights."

23. It was a gross **ERROR** to claim, "it is not the practice of this Board to consider affidavits filed with a request

for recosideration. In re Martin, 154 F.2d 126, 69 USPQ 75 (CCPA 1946)." [A20].

24. Absolute proof of the thesis of this **NEW DRUGS** ability to relieve the pain and heal the tissue damage caused by Arthritis, Neuralgia, Respiratory, or Cancer disease is **UNKNOWN** in **ALL THE MEDICAL WORLD.**

25. For the past two years I´ve been priviledged to communicate these ideas to **ONCOLOGY TECHNOLOGIES INC.** Irving, California [71]. Two studies are now in my possession validating my thoughts. It is my pleasure to present to you that Cancer is being recognized as within my **NEW DRUGS** realm of scientific laboratory study leading to positive reporting of control.

26. In re Brama 34 USPQ 2d page 1442:

> "FDA approval, however, is not a prerequisite for finding a compound useful within the meaning of the patent laws. Scott, 34 F.3d 1058, 1063, 32 USPQ 2d 1115, 1120. Usefulness in patent law, and in particular in the context of pharmaceutical inventions, necessarily includes the expectation of further research and development. The stage at which an invention in this field becomes useful is well before it is ready to be administered to humans. Were we to require Phase II testing in order to prove utility, the associated costs would prevent many companies from obtaining patent protection on promising new

> inventions, thereby eliminating an incentive to pursue, through research and development, potential cures in many crucial areas such as the treatment of cancer."

CONCLUSION

A. ONCOLOGY TECHNOLOGIES INC. [A71] **FINAL REPORT: EFFECT OF LACTIC ACID ON THE PROLIFERATION OF HUMAN TUMORS**, proves beyond doubt this invention exists, the science community can comprehend it´s usefulness, and further research can expect The Food and Drug Administration approval.

B. In re Hogan, 76-641 (Fed. Cir. 1977), 559 F2d 595, 602 page 595:

> "2. Patents 90(1) Under statute relating to benefit of an earlier filing date with respect to patent application for invention disclosed in an application previously filed in United States by same inventor, patent applicant was entitled to have his several applications viewed as parts of same transaction and constituting one continuous application for the continuing subject matter recited therein. 35 U.S.C.A. § 120."

C. The diseases of Arthritis, of Respiratory, or of Cancer are well known and considered of the most serious threats to health by our medical professionals. As such, it is necessary in this case that the United States

Office of Patent and Trademarks present conditions for patentability evidence seriously challenging all elements of this new drug named Neurolactic Activor.

This has not been done.

D. The patentability evidence that a chemical listed in the Lange Publications is sufficient conditions of patentability, of "inherency", and "in anticpation" of a drug produced or marketed for treatment of these dreaded diseases has not been shown.

E. The Merck Pharmaceuticals listing this new drugs compostions treating the aforementioned diseases as an "OBVIOUS" perception of those skilled in the art does not exist in the market place.

The Writ of Certiorary is granted.

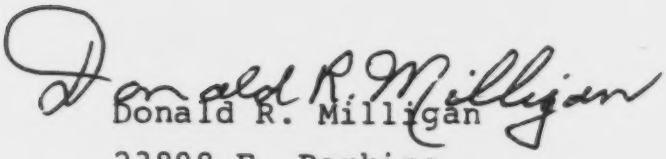
F. This entire Appeal is remanded to The United States Office of Patent and Trademarks with the instructions to:

(1) Provide conditions of patentability evidence within the scope of The United States Code,

OR

(2) Patent this new drug.

Respectfully submitted,



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Incl: Certified Check No._____for $300,<u>00</u>.

August 20, 1997

APPENDIX

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NOTE:Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The dispostion will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

97-1093

(Serial No. 07/796,664)

IN RE DONALD R. MILLIGAN

DECIDED: April 10, 1997

Before SCHALL, Circuit Judge, COWEN, and SKELTON, Senior Circuit Judges. PER CURIAM.

DECISION

Donald R. Milligan appeals the February 22, 1996 decision of the Board of Patent Appeals and Interferences (Board) in Appeal No. 94-0203. In its decision the Board affirmed the examiner's final rejection of all pending claims (1-7) of patent application Serial No. 07/796,664 (the '664 application) for provisional obviousness-type double

patenting over the claims of copending application Serial Number 07/396,361 (the '361 application). The Board also affirmed the examiner's final rejection of all pending claims under the second paragraph of 35 U.S.C. § 112 for indefiniteness, under 35 U.S.C. § 101 and the first paragraph of 35 U.S.C. § 112 for lack of utility, and under the first paragraph of 35 U.S.C. § 112 for lack of enablement. Finally, the Board affirmed the further rejections of claims 1-4 under 35 U.S.C. § 103 for obviousness and under 35 U.S.C. § 102 for anticipation by prior art. The Board denied reconsideration on December 17, 1996. We affirm for lack of utility. We do not reach the other grounds for rejection.

DISCUSSION

Patentable utility is a fact issue. Cross v Iizuka, 753 F.2d 1040, 1044, 224 USPQ 739, 742 (Fed. Cir. 1995). We review the Board's factual determinations under the "clearly erroneous" standard. In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1312 (Fed. Cir. 1996). The '664 application is a divisional application of the '361 application to several inventions, where each invention

asserted a method of curing a different disease. In In re Milligan, No. 96-1419, 101 F.3d 715 (Fed. Cir. 1996) (Table), a nonprecedential decision, we affirmed the Board's rejection of the '361 application for lacking credible utility. The '361 application, after the restriction, claimed a cure for both the symptoms and the cause of arthritis by using formulas of lactic acid. The '664 application claims the identical composition of lactic acid in water and methods of applying this formula to relieve pain and heal damaged tissue. Independent claim 1 is applying this formula to relieve pain and heal damaged tissue. Independent claim 1 is representative of the seven pending claims in the application. It states as follows:

> This aqueous solution of only lactic acid and water will activate the bodies [sic] neural systems to relieve symptoms of neuralgia pain and damage: of angina pectoris, of neural degeneration in the facial, in the hallucinatory, or the neuritis of the muscles and joint damaged functional nerve systems almost immediately and induces tissue repair to remove these symptoms in a manner that has not been a recognized medical procedure.

In affirming the rejections under 35

U.S.C. § 112, the Board found claims 1-7 properly rejected "for being drawn to an incredible utility which is unsupported by any evidence and lack of enablement to practice that utility." The Board incorporated by reference its earlier decisions concerning related applications in Appeal Nos. 94-3318 and 92-2262 for its reasoning on the utility issue. In particular, in Appeal No. 92-2262, the Board noted that Milligan asserted in the specification at issue that the application of a few drops of lactic acid solution acts as a "neurostimulator" which can immediately cure debilitating diseases. The Board concluded that the asserted utility lacked credibility and "can hardly be said to be enabled by the two page descriptive portion of the specification." We find no error in the Board's decision that Milligan has failed to prove that the mere act of placing a solution of lactic acid and water on one's skin will have the beneficial effects claimed in the '664 application.

Finally, in his request for reconsideration, Milligan submitted two affidavits under 37 C.R.R. § 1.132(1996). The Board does not normally consider

affidavits filed with a request for reconsideration absent a showing of good cause for the delay. 37 C.F.R. § 1.195(1996). Since Milligan did not establish good cause for submitting the untimely affidavits, the Board did not abuse its discretion in refusing to consider them.[1] See in re Nielson, 816 F.2d 1567, 1569, 2 USPQ2d 1525, 1526 (Fed. Cir. 1987).

The decision of the Board is affirmed.

---

1 By the same token, we have not considered a laboratory report that Milligan offered as new evidence on appeal.

NOTE:Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The dispostion will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

97-1094

(Serial No. 07/796,663)

IN RE DONALD R. MILLIGAN

DECIDED: April 10, 1997

Before SCHALL, Circuit Judge, COWEN, and SKELTON, Senior Circuit Judges. PER CURIAM.

DECISION

Donald R. Milligan appeals the June 17, 1996 decision of the Board of Patent Appeals and Interferences (Board) in Appeal No. 94-0345. In its decision, the Board affirmed the examiner's final rejection of all pending claims (1-7) of patent application Serial No. 07/796,663 (the '663 application). The Board affirmed the examiner's rejection of all

pending claims in the '663 application under 35 U.S.C. § 101 and the first paragraph of 35 U.S.C. § 112 for lack of utility, under the first paragraph of 35 U.S.C. § 112 for lack of enablement, and under the second paragraph of 35 U.S.C. § 112 as being vague and indefinite. The Board also affirmed the examiner's provisional rejection of claims 1-4 under 35 U.S.C. § 101 as claiming the same invention as claims 1-4 of copending application Serial No. 07/796,664 (the '664 application). Finally, the Board affirmed the rejection of claims 1-7 under 35 U.S.C. § 103 as being unpatentable for reasons of obviousness over prior art. The Board denied reconsideration on August 30, 1996. We affirm for lack of utility, We do not address the other grounds for rejection.

DISCUSSION

We today affirm the Board's decision concerning the '664 application in In re Milligan, Appeal No. 97-1093. The claims of the '663 application present the same issues regarding lack of utility as those in the '664 application. Milligan raises no new arguments in this appeal that we

have not considered in Appeal No. 97-1093. Accordingly, we will not disturb the decision of the Board in this case, and it is affirmed.

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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED, DEC 17, 1996
(stamped PTO) Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD R. MILLIGAN

Appeal No. 94-0203
Application 07/796,664[1]

ON BRIEF

Before JOHN D. SMITH[2], WEIFFENBACH and PAK, Administrative Patent Judges.

PAK,, Administrative Patent Judge.

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[1] Application for patent filed

November 25, 1991.

[2] Administrative Patent Judge Goldstein was part of the original panel but has since retired. Accordingly, the substitution of Administrative Patent Judge John D. Smith has been made for purposes of rendering this decision. See In re Bose, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985)

ON REQUEST FOR RECONSIDERATION

This is a request for reconsideration of our decision of February 22, 1996, wherein we affirmed the examiner's rejection of all the claims.

Appellant appears to argue that the examiner's provisional obviousness-type double patenting rejection of claims 1 through 7 over the claims of copending application Serial Number 07/396,361 was inappropriate under 35 U.S.C. § 121 due to the restriction requirement made by the

examiner in the copending application. The restriction requirement made in the copending application, however, was made between five claims drawn to processes for treating different disease conditions. On the other hand, claims 1 through 7 in the present application and the claims in the copending application over which the rejection was made are drawn to a composition which is simply a dilute solution of lactic acid. Despite the recitation of intended use in these claims, the compositions, per se, are identical. Thus, 35 U.S.C. § 121 has no application to present claims 1 through 7, and the basis of the examiner's provisional rejection was an appropriate one.

Appellant submitted two affidavits under 37 CFR § 1.132 with this request. We will not consider them in the first instance absent a showing of good cause. 37 CFR § 1.195; In re Martin, 154 F.2d 126, 129, 69 USPQ 75, 77 (CCPA 1946).

We have carefully considered appellant's arguments with respect to the

remaining rejections on appeal, but we find that they raise no points not considered previously in the prior decisions incorporated by reference in the decision in this appeal. We are still unconvinced that there was error in the rejection of the claims on appeal.

Appellant's request for reconsideration has been granted to the extent of reconsidering our decision but is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

s/JOHN D. SMITH
Administrative Patent Judge

s/CAMERON WEIFFENBACH
Administrative Patent Judge

s/CHUNG K. PAK
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 94-0203
Application 07/796,664

Donald R. Milligan
23808 E. Perkings
Broken Arrow, OK 74014-2525

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NOTE:Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The dispostion will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

96-1419

(Serial No. 07/396,361)

IN RE DONALD R. MILLIGAN

DECIDED: November 13, 1996

Before MICHEL, PLAGER, and BRYSON, Circuit Judges.

PER CURIAM.

Donald R. Milligan ("Milligan") appeals from the March 29, 1996 decision of the Board of Patent Appeals and Interferences ("the Board") denying Milligan´s request for reconsideration of the February 22, 1996 decision of the Board and reaffirming the original decision upholding the examiner´s final rejections of all of the pending claims; namely 14 to 16 and 18 to 21. All the

pending claims of the application were rejected under 35 U.S.C. § 101 for lack of evidence related to the claimed utility, under the first paragraph of 35 U.S.C. § 112 for lack of an enabling disclosure, and under the second paragraph of 35 U.S.C. § 112 as being indefinite. Claim 14 was also rejected under 35 U.S.C. § 102 as being anticipated by the Lange reference. We affirm.

Claim 14, the sole independent claim of Milligan's application, reads as follows:

> These formulas of lactic acid in composition with water reieves [sic] symptoms of joint or muscle pain, the causation of arthritis, or wrenched joints, almost immediately and induces tissue repair to remove these symptoms.

The asserted utility of Milligan's claimed inventions - a cure for both the symptoms and the cause of arthritis - is incredible on its face, and he has utterly failed to prove that the mere act of placing a solution of lactic acid and water on one's skin will have any of the claimed beneficial effects. Milligan points only to two "affidavits" consisting of pages taken from several of his journals which recite his various ailments and his attempts to cure those

ailments. These affidavits were not submitted to the Patent and Trademark Office until Milligan filed his request for reconsideration with the Board; as Milligan failed to show good cause for the delay, they were properly not considered by the Board. 37 C.F.R. § 1.195. Moreover, even if the affidavits had been considered timely, they contain only Milligan's self-serving and entirely subjective comments that he stopped experiencing pain after rubbing sauerdraut juice or a lactic acid solution over his body, they do not contain any mention of relieving "the causation of arthritis, or wrenched joints, almost immediately and induc[ing] tissue repair. . . ." (emphasis added); nor do they contain the results of any scientifically conducted survey.

Thus, as we conclude as a matter of law that those of reasonable skill in the art would not find Milligan's contentions of utility credible, we must affirm that ground of rejection. In light of the lack of utility of Milligan's claimed invention, we need not reach the other grounds of rejection.

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED, AUG 30, 1996
(stamped PTO) Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD R. MILLIGAN

Appeal No. 94-0345
Application 07/796,663[1]

ON BRIEF

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[1] Application for patent filed November 25, 1991. According to applicant, the application is a division of Application 07-396,361, filed August 21, 1989 (ABN).

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Appeal No. 94-0345
Application 07/796,663

Before GOLDSTEIN, WEIFFENBACH and PAK, Administrative Patent Judges.

GOLDSTEIN, Administrative Patent Judge.

REQUEST FOR RECONSIDERATION

This is a request for reconsideration of our decision of June 17, 1996, wherein we affirmed the examiner´s rejection of all the claims.

We affirmed the examiner´s rejection of claims 1 to 4 under 35 USC § 101, made conditionally over the claims of copending application Serial Number 07/796,664. That application has now been abandoned, and the rejection may thus be moot. In the event that a continuing application with similar claims has been filed, however, we should note that we consider the rejection to have been correct despite appellant´s arguments in the request for reconsideration. The restriction requirement made in the first application

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in this series, application Serial No. 07/396,361, was made between five claims drawn to processes of treating different disease conditions. Claims 1 to 4 in the present application and the claims in the copending application over which the rejection was made are drawn to a composition which is simply a dilute solution of lactic acid. Despite the recitation of intended use in these claims the compositions per se are identical. Thus 35 USC § 121 has no application to present claims 1 to 4, and the basis of the examiner's provisional rejection was an appropriate one.

An affidavit under 37 CFR § 1.132 was filed with the request, but it is not the practice of this Board to consider affidavits filed with a request for reconsideration. In re Martin, 154 F.2d 126, 69 USPQ 75 (CCPA 1946).

We have carefully considered appellants' arguments with respect to the remaining rejections on appeal, but we find that they raise no points not considered previously in the prior

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decisions incorporated by reference in the decision in this appeal. We are still unconvinced that there was errpr in the rejection of the claims on appeal.

Appellants request for reconsideration has been granted to the extent of reconsidring our decision but is denied with respect to making any changes therein.

DENIED

s/MELVIN GOLDSTEIN)
Administrative Patent Judge)

s/CAMERON WEIFFENBACH)
Administrative Patent Judge)

s/CHUNG K. PAK)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 94-0345
Application 07/796,663

Donald R. Milligan
23808 E. Perkings
Broken Arrow, Oklahoma 74014-2525

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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED, JUN 17, 1996
(stamped PTO) Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD R. MILLIGAN

Appeal No. 94-0345
Application 07/796,663[1]

ON BRIEF

Before GOLDSTEIN, WEIFFENBACH, and PAK, Administrative Patent Judges.
GOLDSTEIN, Administrative Patent Judge.

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[1] Application for patent filed

[1] November 25, 1991. According to applicant, the application is a division of Application 07/396,361, filed August 21, 1989, abandoned.

DECISION ON APPEAL

This appeal is from the examiner's final rejection of claims 1 to 7, which are all of the claims in the application.

Illustratiave claim 1 is reproduced below:

> 1. This aqueous solution of only lactic acid and water activates the bodies neuro-systems, imune systems, or nervous systems to relieve pain and heal nasal damage, bronchial congestion, sore throat, sinus drippage, coughing, or the common cold symptoms almost immediately and induces tisssue repair in a manner that has not been a recognized medical procedure.

References relied on by the examiner on appeal are:

Lange's Handbook of Chemistry, 7-472 (John A. Dean, ed., 13th ed., McGraw-Hill Book Co., 1985)

The Merck Index, 768 (Martha Windholz, ed., 10th ed., Merck & Co., Inc., 1983)

All of the appealed claims have been finally rejected under 35 U.S.C. § 101 and the first paragraph of 35 U.S.C. § 112 as lacking to enable the practice of that utility. All of the appealed claims have been finally rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in numerous respects. Claims 1 to 4 have been provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as claims 1 to 4 of copending application Serial No. 07/796,664. Claims 1 to 4 have been finally rejected under 35 U.S.C. § 102 as being anticipated by Lange's Handbook of Chemistry. Claims 1 to 7 have been finally rejected under 35 U.S.C. § 103 as being unpatentable for reasons of obviousness over The Merck Index. We shall affirm all of these rejections.

There have been three earlier decisions on appeal in related applications. The descriptive portions of the specifications and the claims on appeal were either identical or almost identical to those in the present case.

The only difference was in the specific physiological problems alleged and recited in the claims as being cured or ameliorated. These were either completely different or overlapping with the list of physiological problems recited in the present claims. It will be noted that only the claims we assume to be intended to be drawn to compositions have been rejected provisionally for double patenting. The compositions themselves are identical and it is only the intended use recitation which differs.

The prior applications are: Serial No. 07/396,361 (Appeal No. 94-3313); Serial No. 07/796,664 (Appeal No. 94-0203). The opinion in the last-mentioned appeal physically incorporated the opinion in the penultimately-mentioned appeal. Since the issues are identical, as are the examiner's position and appellant's position, in the interest of judicial economy, as support for this decision of affirmance, we shall simply adopt the

examiner's position set forth in the answer on appeal and the supplemental answer on appeal as our own. For further explication, we refer to and incorporate by reference the opinions supporting the decisions in the three aforementioned earlier appeals.

For the record, we should note that we have considered appellant's arguments on appeal but, as we have stated above, they do not differ materially from those presented with respect to the identical issues in the earlier appeals and we found them equally unconvincing of error here.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

s/MELVIN GOLDSTEIN
Administrative Patent Judge

s/CAMERON WEIFFENBACH
Administrative Patent Judge

s/CHUNG K. PAK
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 94-0345
Application 07/796,663

Donald R. Milligan
23808 E. Perkings
Broken Arrow, OK 74014-2525

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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED, MAR 29, 1996
(stamped PTO) Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD R. MILLIGAN

Appeal No. 94-3318
Application 07/396,361[1]

ON BRIEF

Before GOLDSTEIN, WEIFFENBACH, and PAK, Administrative Patent Judges.
GOLDSTEIN, Administrative Patent Judge.

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[1] Application for patent filed August 21, 1989.

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ON REQUEST FOR RECONSIDERATION

We have assumed that appellant's paper filed March 18, 1996 (Paper No. 32), is intended to be a request for reconsideration of our decision of February 22, 1996, wherein we affirmed the examiner's rejection of all of the claims.

The initial issue raised by appellant has to do with the numbering of the claims. Evidently, appellant's final amendment tc claim 17 (Paper No. 27) was considered to be a cancellation of claim 17 and the addition of a new claim 21. This decision on the part of the examiner and/or clerical staff appears to have been correct since essentially the entire recitation of the claim was changed. This issue is not properly within our jurisdiction, but we would point out that the claim appellant intended to have considered as claim 17 has been considered as claim 21 and, thus, there was no error in the subject matter under appeal, simply a difference in claim numbering.

All of appellant's arguments to the merits have been previously considered, i.e., no points not considered previously have been raised. Thus, our opinion is unchanged.

Affidavits under 37 CFR § 1.132 were filed with the request for reconsideration, but it is not the practice of this board to consider affidavits filed with a request for reconsideration. In re Martin, 154 F.2d 126, 69 USPQ 75 (CCPA 1946).

Appellant's request for reconsideration has been considered but is denied with respect to making any change in our decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

s/MELVIN GOLDSTEIN
Administrative Patent Judge

s/CAMERON WEIFFENBACH
Administrative Patent Judge

s/CHUNG K. PAK
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Donald R. Milligan
23808 E. Perkins
Broken Arrow, OK 74014

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED, FEB 22, 1996
(stamped PTO) Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DONALD R. MILLIGAN

Appeal No. 94-0203
Application 07/796,664[1]

ON BRIEF

Before GOLDSTEIN, WEIFFENBACH, and PAK, Administrative Patent Judges.
GOLDSTEIN, Administrative Patent Judge.

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[1] Application for patent filed November 25, 1991.

Appeal No. 94-0203
Application 07/796,664

DECISION ON APPEAL

This appeal is from the examiner's final rejection of claims 1 to 7. There are no allowed claims. Illustrative claim 1 is reproduced below:

> 1. This aqueous solution of only lactic acid and water will activate the bodies neural systems to relieve symptoms of neuralgia pain and damage: of angina pectoris, of neural degeneration in the facial, in the hallucinatory, or the neuritis of the muscles and joint damaged functional nerve systems almost immediately and induces tissue repair to remove these symptoms in a manner that has not been a recognized medical procedure.

The references relied on by the examiner on appeal are:

> John A. Dean, ed., **Lange's Handbook of Chemistry**, 7th section, 81 & 472 (13th ed., McGraw-Hill Book Co., NY, 1985).
>
> Martha Windholz et al., eds., **The Merck Index**, abstract no. (sic) 5173, 768 (10th ed., Merck & Co., Inc., Rahway, NJ, 1983 (sic)

All of the appealed claims have been finally rejected under the second

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paragraph 35 U.S.C. § 112 for indefiniteness and under being drawn to an incredible utility which is unsupported by any evidence and lack of enablement to practice that utility. We shall affirm these rejections.

Although we have carefully considered all of appellant's arguments, we find them unconvincing of error on the part of the examiner in making these rejections.

Except for the specific nature of the physical conditions treated by the claimed compositions (to the extent that the conditions recited can be considered specific), the claims in this application are identical to the claims in copending application Serial No. 07/396,361, in which we are mailing concurrenty with this decision, a decision in Appeal No. 94-3318. In the interest of judicial economy, we are attaching a copy of that decision (and a copy of an earlier decision in the same application referred to in that decision) to this decision as an ample illustration of our reasons for

agreeing with the examiner's rejection and finding appellant's arguments to be unconvincing of error in the examiner's position.

Claims 1 to 7 have been finally rejected provisionally under the nonstatutory type of double patenting as being unpatentable over the claims of the above referred to copending application. We shall affirm this rejection.

The claims which we assume are intended to be composition claims (claims 1 to 4) are identical in their only material limitations to corresponding claims in the copending application. To the extent that claims 5 to 7 are properly interpreted as process claims, the conditions recited overlap the conditions recited in the copending application to the extent that this type of rejection is appropriate.

Appellant's arguments against this rejection beg the question in not dealing with the material issues, apparently because appellant has misconstrued the nature of this type of rejection. Thus

we summarily find appellant's arguments on their face to be unconvinging of error.

Claims 1 to 4 have been finally rejected under 35 U.S.C. § 103 as being unpatentable over **The Merck Index** and under 35 U.S.C. § 102 as being unpatentable over **Lange's Handbook of Chemistry.** We shall affirm these rejections.

The compositions, or minor differences in concentration of such compositions, are literally described in both references. Again, appellant's arguments beg the question and rely on a recitation of intended results of use of the compositions (which asserted results we have found to be incredible) and not the material issues. Thus we can perceive of nc benefit from dissecting those arguments. They are upon mere cursory reading ineffective.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

s/MELVIN GOLDSTEIN
Administrative Patent Judge

s/CAMERON WEIFFENBACH
Administrative Patent Judge

s/CHUNG K. PAK
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 94-0203
Application 07/796,664

Donald R. Milligan
23808 E. Perkings
Broken Arrow, OK 74014

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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

MAILED, FEB 22, 1996
(stamped PTO) Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DONALD R. MILLIGAN

Appeal No. 94-3318
Application 07/396,361[1]

ON BRIEF

Before GOLDSTEIN, WEIFFENBACH, and PAK, Administrative Patent Judges.
GOLDSTEIN, Administrative Patent Judge.

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[1] Application for patent filed August 21, 1989.

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DECISION ON APPEAL

This appeal is from the examiner's final rejection of claims 14 to 16 and 18 to 21, which are all of the claims remainging in the application. Illustrative claim 14 is reproduced below:

14. These formulas of lactic acid in composition with water relieves symptoms of joint or muscle pain, the causation of arthritis, neuralgia, rheumatic, or wrenched joints, almost immediately and induces tissue repair to remove these symptoms.

The sole reference relied on by the examineer on appeal is:

Norbert A. Lange (Lange), **Handbook of Chemistry**, 554-55 (7th ed., Handbook Publishers, Inc., Sandsky, OH, 1949).

All of the appealed claims have been finally rejected under 35 U.S.C. § 101 for a lack of evidence related to the incredible utility claimed, under the first paragraph of 35 U.S.C. § 112 for lack of an enabling disclosure to practice the utility claimed, and under

the second paragraph of 35 U.S.C. § 112 as being indefinite for numerous reasons. We shall affirm these rejections.

In setting forth the rejections in the answer on appeal, the examiner attempted to paraphrase the new grounds of rejection which we set forth in our decision in the prior appeal of this applicaation (Appeal No. 92-2262, Paper No. 24 in this file). Neither the claims nor appellant's arguments have changed substantially since that time. Also, no evidence of operability of the asserted utility has been made of record. Appellant seems to consider his assertions to be acceptable evidence. This is of course incorrect. In an attempt to avoid burdening the present lengthy record in this application, we shall here simply adopt and incorporate by reference our earlier decision since it is still applicable.

Claim 14 has been finally rejected under 35 U.S.C. § 102 as being anticipated by Lange. We shall affirm this rejection.

Our reasons for affirming this rejection are also treated in our prior decision. Appellant's argumnet simply overlooks the fact that it is not necessary for all of the asserted properties and utilities of a composition to be disclosed to constitute a description. The sole material limitation of claim 14 (assuming it is intended to describe a composition) is that it is a solution of lactic acid in water. Lange discloses such a solution.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

s/MELVIN GOLDSTEIN
Administrative Patent Judge

s/CAMERON WEIFFENBACH
Administrative Patent Judge

s/CHUNG K. PAK
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND INTERFERENCES

Donald R. Milligan
23808 E. Perkins
Broken Arrow, OK 74014

MAILED, JUN 20, 1995
(stamped PTO) Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD R. MILLIGAN

Appeal No. 94-0345
Application 07/796,663[1]

ORDER REMANDING TO EXAMINER

A review of the file reveals that a new ground of rejection was raised in the Examiner's Answer entered July 23, 1993 (Paper No. 16). The Applicant filed a

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[1] Application for patent filed November 25, 1991. According to applicant, the application is a division of Application 07-396,361, filed August 21, 1989.

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Reply Brief in response to the new ground of rejection on August 23, 1993 (Paper No. 18). The examiner acknowledged the Reply Brief in a communication entered on October 15, 1993 (Paper No. 19). Section 1208.04 of the Manual of Patent Examining Procedure states:

> If the reply brief was filed in response to a new ground of rejection in the examiner's answer, the examiner must issue a supplemental answer indicating whether the new ground of rejection has been overcome, and, if it has not, explaining why not.

The communication of October 15, 1993 (Paper No. 19) does not comply with the above requirement.

Further review of the file reveals that an Advisory Action was filed February 4, 1993 (Paper No. 11) indicating that amendment would be entered upon filing of appeal; however, no such amendment could be located within the file.

Accordingly, it is (sic)

ORDERED that the application is remanded to Examiner for proper response to the new ground of rejection per the Answer entered July 23, 1993 (Paper No. 16), to provide copy of amendment or correction of advisory action, and for such further action as may be appropriate.

The application, by virtue of its "special" status, requires immediate action. See Manual of Patent Examining Procedure, § 708.01(d). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal.

BOARD OF PATENT APPEALS
AND INTERFERENCES

s/MERRELL C. CASHION, JR.
Program and Resource
Administrator

cc: Donald R. Milligan
23808 E. Perkins
Broken Arrow, OK 74014-2525

Art Unit 1205 Paper No. 24

Appeal No. 92-2262 svt

MAILED
MAY 14, 1993
PTO APPEALS
& INTERFERENCES

ON BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD R. MILLIGAN

Application for Patent filed August 21, 1989, Serial No. 396,361. A Method of Inducing Tissue Repair.

Donald R. Milligan pro se.

Supervisory Primary Examiner - Frederick E. Waddell.
Examiner - Kevin E. Weddington.

Before Goldstein, Pellman and Goolkasian, Examiners-in-Chief.
Goldstein, Examiner-in-Chief.

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This appeal is from the examiner's final rejection of claims 14 to 20, which are all of the claims remaining in the application. Illustrative claims 14 and 15 are reproduced below:

14. This aqueous solution of only lactic acid and water relieves symptoms of joint or muscle pain, the causation of arthritis, neuralgia, rheumatic, or wrenched joints, almost immediately and induces tissue repair to remove these symptoms.

15. The composition of claim 14 is one drop of lactic acid, 85% purity, in 600 drops of water (approximately one ounce of water).

A copy of the remaining claims on appeal is appended to this opinion.

References relied on by the examiner on appeal are:

Wieland	1,772,975
Aug. 12, 1930	
Holman	3,124,506
Mar. 10, 1964	
Van Scott et al. (Van Scott)	4,021,572
May 3, 1977	
Wildnauer et al. (Wildnauer)	4,294,852
Oct. 13, 1981	

Cavanak et al. (Cavanak). **Chem. Abstr.**, **111**:140515g (1989).

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Reference cited by the Board of Appeals under 37 C.F.R. 1.196(b) is:

Lange (Editor), **Handbook of Chemistry**, Seventh Edition, Handbook Publishers, Inc., Sandusky, OH, pp, 554-555 (1949).

All of the appealed claims have been finally rejected under 35 U.S.C. 103 as being unpatentable over the references cited above. The rejection appears to be over each reference taken individually, although this is not immediately discernable from the examiner's statement of the rejection in the answer. At any rate, our decision would be the same whether the rejection were considered to be made over the references taken individually or combined. We shall reverse the examiner's rejection.

Claim 14, as apparently interpreted by the examiner, is drawn to a composition (we shall have more to say about the form of the claims below). That composition is a "solution of only lactic acid and water" (emphasis added). Claim 15 (and perhaps additional claims) recites a specific concentration of lactic acid in water. The examiner has failed to deal with the latter limitation

at all. As to the former limitation, all of the references relied on appear to disclose compositions containing essential, additional ingredients. The examiner has presented no explanation for why it would have been obvious to eliminate those ingredients. He has stated only the following: "The reference makes it clear that the claimed combination is old." This rejection is clearly unsustainable.

Under the the provisions of 37 C.F.R. 1.196(b), we make the following new rejections.

Claim 14 to 20 are rejected under 35 U.S.C. 101/112 as lacking utility or being based on an insufficient enabling disclosure with respect to practicing the asserted utility without the exercise of undue experimentation.

The alleged utility for appellant's solution of lactic acid and water, as specifically recited in claim 14, is to relieve not only the pain but also the "causation" of such diseases as arthritis or such injuries as "wrenched joints" and to do so "almost immediately" (claim 14)

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upon the application of one or two drops (claim 18). There is very little more to the descriptive portion of the specification, but it is asserted that the mechanism of action is as a "neurostimulator" which causes a "neuroreaction," which reaction produces the desired effect. This asserted utility is incredible on its face, and its practice can hardly be said to be enabled by the two page descriptive portion of the specification. Although we believe that the defects in appellant's specification and claims are manifest merely upon inspection, we would cite as relevant precedent **In re Houghton**, 433 F.2d 820, 167 USPQ 687 (CCPA 1970); **In re Fisher**, 427 F.2d 833, 166 USPQ 18 (CCPA 1970); **In re Eltgroth**, 419 F.2d 918, 164 USPQ 221 (CCPA 1970); **In re Perens**, 417 F.2d 1072, 163 USPQ 609 (CCPA 1969); **Ex parte Kranz**, 19 USPQ2d 1216 (BPAI 1990); **Ex parte Maas**, 9 USPQ2d 1746 (BPAI 1987); **Ex parte Busse**, 1 USPQ2d 1908 (BPAI 1986).

Claims 14 to 20 are rejected under the second paragraph of 35 U.S.C. 112

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as being indefinite.

Claims 18 to 20 recite a "method of application," but they are dependent on claim 15 or 16, each of which is drawn to a "composition."

In treating the examiner's rejection and the new ground of rejection set forth above, we interpreted claim 14 auguendo as though it read as follows: "An aqueous solution . . . which relieves . . . ." The actual construction of the claim begins with the following recitation: "This aqueous solution of only lactic acid and water relieves." Such a recitation does not clearly define a composition and is manifestly indefinite.

The claims are fraught with additional indefinite constructions which we shall not enumerate here, but which should be apparent to the examiner upon rereading. Merely for example, claims which recite that a composition "may also be increased or decreased" are indefinite on their face.

Claim 14 is rejected under 35 U.S.C. 102 as being anticipated by Lange. The disclosure of the fact that lactic acid

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is water soluble is a fortiori a disclosure of an aqueous solution.

The decision of the examiner is reversed and new grounds of rejection are raised under 37 C.F.R. 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR 1.197). Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR 1.196(b) by way of showing of facts not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

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1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989). 1105 O.G. 5 (August 1. 1989).

RAVERSED 37 C.F.R. 1.196(b).

s/Melvin Goldstein)
Examiner-in-Chief)
)
s/Irving R. Pellman)
Examiner-in-Chief)
)
s/John T. Goolkasian)
Examiner-in-Chief)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Donald R. Milligan
23808 E. Perkins
Broken Arrow, OK 74014

07/396,361, ORIGINAL CLAIMS, DATED AUGUST 21, 1989.

DECLARATION OF PATENT CLAIMS
by Donald R. Milligan

NAME: NEUROLACTIC ACTIVOR

ONE--JOINT PAIN as in wrenched joints, arthritic, rheumatic, or neuralgic pain is diminished if not eliminated almost immediately (minutes). This type of pain is then treated by normal body healing techniques to eliminate the cause.

It is no miracle drug. It is a neurostimulator rallying the brains healing forces to the area and causing an immediate reaction to prevent pain and instigate the healing processes of the body.

TWO--SMALL WOUNDS as in bruises, cuts, insect bites, pimples, blisters, or infections are relieved of pain and the same type of healing is applied.

THREE--MUSCLE PAIN as in pulled muscles,

ligaments, or cramps are releived of pain and the healing process for the area is initiated.

FOUR--RESPIRATORY as in coughing, nasal congestion, sinus congestion, or lung congestion is relieved of the congestive mucus and irritation quite rapidly.

FIVE--CANCER as in minor skin lesions and diagnosed malignant nose cancer pain and itching is rapidly reduced. The healing process is positive and results are positive.

/ / / / / / / END OF CLAIMS / / / / / / /

14 These formulas of lactic acid in composition with water relieves symptoms of joint or muscle pain, the causation of arthritis, or wrenched joints, almost immediately and induces tissue repair to remove these symptoms.

15 The composition of Claim 14 is one (1) drop of lactic acid, eighty five (85) percent purity, in six hundred (600) drops of water.

16 The composition of Claim 14 may also be decreased to one (1) drop of lactic acid in nineteen thousand, two hundred (19,200) drops of water.

17 The composition of claim 14 is limited to not more than one (1) drop of lactic acid in sixty (60) drops of water.

18 The method of application of Claim 15 is in a one (1) or two (2) drop increment to the damaged area and then wait until the symptoms return before any

reapplication.

19 The method of application of Claim 16 is as a spray over a larger general area, and again, it is wait until the symptoms return before any reapplication.

20 The method of application of Claim 15 to a severely damaged joint or muscle whose pain is not diminished rapidly is to reapply the solution in two (2) to four (4) hour intervals in a one (1) or two (2) drop increments until the healing process is initiated then discontinued until the symptoms return.

//////////////END OF CLAIMS///////////////

Appeal No. 94-0345
Application 07/796,663

PTO Paper No. 19 dated 10/15/93 forwarded the Appeal **WITHOUT** forwarding my Amendment authorized by Paper No. 16, dated 07/23/93.

AMENDED CLAIMS MILLIGAN 07/976,663, Paper 18, dated Aug 16, 1993

DECLARATION OF PATENT CLAIMS by
Donald R. Milligan

TITLE: A METHOD OF REDUCING PAIN AND INDUCING TISSUE REPAIR (RESPIRATORY).

1-- These formulas of lactic acid in composition with water activates the bodies neuro-systems, immune systems, or nervous systems to relieve pain and heal nasal damage, bronchial congestion, sore throat, sinus drippage, coughing, or the common cold symptoms almost immediately and induces tissue repair in a manner that has not been a recognized medical procedure.

2-- The composition of Claim 1 is one (1) drop of lactic acid, 85% purity, in

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six hundred (600) drops of water.

3-- The composition of Claim 1 may also be decreased to one (1) drop of lactic acid in nineteen thousand, two hundred (19,200) drops of water.

4-- The composition of claim 1 is limited to not more than one (1) drop of lactic acid in sixty (60) drops of water.

5-- The method of application of Claim 2 is in a one (1) or two (2) drop increment to the damaged area and then wait until the symptoms return before any reapplication. i.e. across the forehead sinus, the cheekbones and bridge of the nose, along the throat and down the sturnam.

6-- The method of application of Claim 3 is as a spray over the same general area, and again, it is wait until the symptoms return before any reapplication.

7-- The method of application of Claim 1

to a severe degenerative congestion whose symptoms are not diminished rapidly is to reapply the solution in two (2) to four (4) hour intervals in a one (1) or two (2) drop increments or the spray solution until the healing process is initiated then discontinued until the symptoms return.

/ / / / / / / / / / / /END OF CLAIMS / / / / / / / / / / / /

Appeal No. 94-0203
Application 07/796,664

PTO Paper No. 21 dated 10/15/93 forwarded the Appeal **WITHOUT** forwarding my Amendment authorized by Paper No. 19.

AMENDED CLAIMS MILLIGAN 07/976,664, Paper 20, dated Sept 13, 1993

DECLARATION OF PATENT CLAIMS by
Donald R. Milligan

TITLE: A METHOD OF REDUCING PAIN AND INDUCING TISSUE REPAIR

1-- These formulas of lactic acid in composition with water will activate the bodies neural systems to relieve symptoms of neuralgia pain and damage: of angina pectoris, of neural degeneration in the facial, in the hallucinatory, or the neuritis of the muscles and joint damaged functional nerve systems almost immediately and induces tissue repair to remove these symptoms in a manner that has not been a recognized medical procedure.

Claims 64 1

2-- The composition of Claim 1 is one (1) drop of lactic acid, eighty five (8) percent purity, in six hundred (600) drops of water.

3-- The composition of Claim 1 may also be decreased to one (1) drop of lactic acid in nineteen thousand, two hundred (19,200) drops of water.

4-- The composition of claim 1 is limited to not more than one (1) drop of lactic acid in Sixty (60) drops of water.

5-- The method of application of Claim 2 is in a one (1) or two (2) drop increment to the damaged area and then wait until the symptoms return before any reapplication.

6-- The method of application of Claim 3 is as a spray over a larger general area, and again, it is wait until the symptoms return before any reapplication.

7-- The method of application of Claim 1

to a severely damaged joint or muscle whose pain is not diminished rapidly is to reapply the solution in two (2) to four (4) hour intervals in a one (1) or two (2) drop increments or the spray solution until the healing process is initiated then discontinued until the symptoms return.

/ / / / / / / / / / / / /END OF CLAIMS / /
/ / / / / / / / / / /

MILLIGAN, 08/744,286, 11/06/96, THIS APPLICATION IS DIV OF 07/396,361, 08/21/89.

THE DECLARATION OF PATENT CLAIMS by
Donald R. Milligan

TITLE: A METHOD OF REDUCING PAIN AND INDUCING TISSUE REPAIR - - **(CANCER)**

CLAIM ONE This new drug consisting of two substances, neither of which is a new drug, contains an active agent in a strength of sixteen hundredths (.16) percent lactic acid and an inert substance of ninty nine and eighty four hundredths (99.84) percent sterile water, is designed to relieve the pain and initiate the healing process treating the damaged tissue of cancer.

CLAIM TWO The composition of Claim 1 is one (1) drop of lactic acid, eighty five (85) percent purity, in six hundred (600) drops of sterile water.

CLAIM THREE The composition of Claim 1 may also be decreased to one (1) drop of lactic acid, eighty five (85) percent

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MILLIGAN, 08/744,286, 11/06/96, THIS APPLICATION IS DIV OF 07/396,361, 08/21/89.

TITLE: A METHOD OF REDUCING PAIN AND INDUCING TISSUE REPAIR - - **(CANCER)**

purity, in nineteen thousand, two hundred (19,200) drops of sterile water.

CLAIM FOUR The composition of claim 1 is limited to not more than one (1) drop of lactic acid in sixty (60) drops of sterile water.

CLAIM FIVE The method of application of Claim 2 is in a one (1) or two (2) drop increment to the damaged area and then wait until the symptoms return before making any reapplication.

CLAIM SIX The method of application of Claim 3 is as a spray over a larger general area, and again, it is wait until the symptoms return before any reapplication.

CLAIM SEVEN The method of application of Claim 2 or Claim 3 to severely damaged

MILLIGAN, 08/744,286, 11/06/96, THIS APPLICATION IS DIV OF 07/396,361, 08/21/89.

TITLE: A METHOD OF REDUCING PAIN AND INDUCING TISSUE REPAIR - - **(CANCER)**

tissue or area whose pain is not diminished rapidly is to reapply the solution in two (2) to four (4) hour intervals in a one (1) or two (2) drop increments or the spray until the healing process is initiated then discontinued until the symptoms return.

/ / / / / / / /END OF CLAIMS/ / / / / / /